

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

QUAD INT'L, INCORPORATED,

Opposer,

vs.

ANDREA FISCHER,

Applicant.

Opposition No.: 91160119

Serial No.: 76/516972

Mark: CHLOE VEVRIER

Published: March 23, 2004

CERTIFICATE OF MAILING

I hereby certify that on June 1, 2005, this paper is being deposited with the U.S. Postal Service by "Express Mail Post Office to Addressee" service with Express Mail Label No. ED 830246741 US, for delivery to the United States Patent and Trademark Office, Madison Building, 600 Dulany Street, Alexandria, VA 22313.

LAURA GANOZA

OPPOSER'S MOTION FOR SANCTIONS

Opposer, Quad Int'l Incorporated, ("Opposer") by and through its undersigned counsel, and pursuant to 37 C.F.R. § 2.120(g)(1) and TMBP § 703.01(p), hereby files its Motion for Sanctions against Applicant, Andrea Fischer ("Applicant") due to her improper disclosure of confidential information as defined in the Parties' Stipulated Protective Order ("Protective Order"). The Protective Order governs the distribution and dissemination of confidential information during these proceeding. In support of this motion, Opposer states as follows:

INTRODUCTION

In blatant disregard of the Protective Order, Applicant, without legal justification or excuse, submitted highly confidential and extremely sensitive documents to the Board ostensibly in its response to Opposer's motion for summary judgment. By filing *all* exhibits attached to



John Fox's deposition, Applicant divulged Opposer's discovery responses, certain of which were marked CONFIDENTIAL. Applicant also revealed other documents marked HIGHLY CONFIDENTIAL- ATTORNEYS' EYES ONLY. Applicant's casual and inconsiderate disregard of her duty with respect to Opposer's confidential documents is untenable. Additionally, Opposer's cavalier tactics concerning her discovery obligations is disconcerting. Indeed, Applicant represented to Opposer during the discovery process that she had produced all responsive documents in her possession. Notwithstanding Applicant's unambiguous representation, she inexplicably located responsive documents just in time to respond to Opposer's motion for summary judgment. Applicant's flagrant violation of the Board's Protective Order and discovery requirements cannot be excused. Judgment should be entered against her Applicant, and the registration denied. At the very least, her recent summary judgment filings should be stricken and/or denied.

STATEMENT OF FACTS

Realizing that confidential information would need to be exchanged between the parties in discovery, the parties agreed to enter into a Protective Order at the commencement of the discovery period. Opposer was especially concerned with the disclosure of its highly sensitive sales and advertising information. Specifically, Opposer sought to preclude the public disclosure of trade secret information to prevent affording competitors an unfair advantage. As a result, the parties negotiated the terms of the Protective Order and specifically included a provision (as suggested by the Board's own proposed form protective order) requiring all confidential documents to be filed under *seal*. The parties signed and filed the Protective Order in August, and it was noted by the Board on September 14, 2004. Attached hereto as Exhibit "A" is a copy of the fully executed Protective Order.

In compliance with the Protective Order, Opposer ensured that all confidential documents it filed with the Board were filed under seal and in compliance with 37 C.F.R. § 2.27(e). Conversely, Applicant ignored this provision of the Protective Order and exposed to the public Opposer's highly confidential and trade secret information.

Unfortunately for Opposer, this is not the first instance Applicant disregarded her discovery obligations. In contravention of the rules governing discovery, and the rules governing evidence that may be submitted in support of a motion for summary judgment, Applicant filed two, never before produced documents in support of her response to Opposer's Motion for Summary Judgment, and in support of her own Cross-Motion for Summary Judgment. Specifically, Opposer proffered an unauthenticated, translated-from-German statement from her former lover, Dr. Dieter Boers. Additionally, she submitted to the Board a list of publications in which Applicant's photographs allegedly appeared for the years 1993 through 1998. Neither of these documents were produced to Opposer during discovery. In fact, in response to discovery requests specifically requesting such information, Applicant responded that she had no such records in her possession.

As fully set forth below, Applicant's obstreperous conduct warrants sanctions from the Board.

ARGUMENT

The Board's rules provide for the treatment of confidential and trade secret material. The relevant rules state:

Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e). **If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by § 2.120(g).**

37 CFR § 2.125(e); TBMP 703.01(p) (Emphasis added). Accordingly, if a party fails to comply with a protective order, the Board may impose the sanctions provided for under Rule 37(b)(2) of the Federal Rules of Civil Procedure, including striking of the pleadings or parts thereof, or the entry of a default judgment. *See* 37 C.F.R. § 2.120(g)(1); TBMP Section 527.01; *see also Glaxo Group Ltd. v. Genetics Institute Inc.*, 72 U.S.P.Q.2d 1607, 1608 n. 2 (TTAB 2002) (upholding Board's authority to issue protective orders and noting that a party may be sanctioned for violating such orders); *Virgin Enterprises Limited v. Urban Ingenuity Int'l Records, Corp.*, 2001 WL 777064 (TTAB 2001) (entering judgment against applicant for failing to meaningfully participate in discovery and violating discovery order).

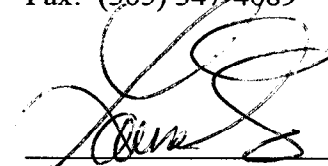
In the instant case, Applicant failed to participate in good faith. Juxtaposed with her hide-the-ball discovery tactics, she employed a slash and burn strategy by ignoring the Protective Order and disclosing Opposer's confidential information. Disregarding the prominent **"CONFIDENTIAL"** and **"HIGHLY CONFIDENTIAL-ATTORNEYS EYES ONLY"** markings on Opposer's documents, Applicant filed all such documents with the Board, without any attempt to file such documents under seal. By engaging in this conduct, Applicant published Opposer's sensitive advertising and sales information. Applicant's antics far exceeds acceptable parameters of assertive litigation. This conduct is unacceptable, highly prejudicial and warrants sanctions. Accordingly, Opposer requests that judgment be entered against Applicant and that her registration be refused. At the very least, Applicant's response to Opposer's Motion for Summary Judgment, and her Cross Motion for Summary Judgment should be stricken from the record or summarily denied.

CONCLUSION

Applicant's failure to adhere to the Protective Order and failure to properly respond to discovery has prejudiced Opposer. Applicant should not be permitted to circumvent rules, eviscerate agreements or otherwise derail these proceedings. Opposer respectfully requests that either judgment be entered in its favor and against Applicant, or that Applicant's summary judgment response and cross-motion be stricken and/or denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing MOTION FOR SANCTIONS was served this 7th day of June, 2005, by mailing by first class mail, postage prepaid, on the attorney named below:

Michael A. Painter, Esq.
Isaacman, Kaufman & Painter
8484 Wilshire Boulevard, Suite 850
Beverly Hills, California 90211



Attorney

CONFIDENTIAL INFORMATION SHALL NOT BE DISCLOSED TO THE PARTIES OR TO ANY EMPLOYEES OR AGENTS OF THE PARTIES. PERSONS, WHO, BY VIRTUE OF THE CONDUCT OF THIS PROCEEDING, HAVE KNOWLEDGE OF THE DESIGNATED CONFIDENTIAL INFORMATION, SHALL NOT SUFFER OR PERMIT THIS DISCLOSURE TO THE PARTIES OR ANY PERSON OR PERSONS NOT ENTITLED UNDER THIS PROTECTIVE ORDER TO RECEIVE SUCH INFORMATION, NOR USE SUCH INFORMATION FOR ANY PURPOSE EXCEPT THIS PROCEEDING, UNLESS AND UNTIL SUCH DESIGNATION IS REMOVED EITHER BY STIPULATION BY COUNSEL FOR THE PARTIES OR BY ORDER OF THE BOARD.

3. The additional individuals permitted to receive and view designated Confidential Information shall be limited to no more than three independent experts or investigators who are not regularly employed by or associated with a party hereto and whose advise, services or consultations are being or will be used by a party hereto in connection with preparation for trial or trial of this action, provided the requirements set forth in Paragraph 4 are complied with.

4. With respect to the individuals identified in Paragraph 3, supra, written notice of the name, address, current employer (if any), and title of each individual shall be furnished to the counsel of record for the producing party at least ten (10) days before access thereto is to be given or such individual, such notice to specify the date when access is to be given. The producing party shall have ten (10) days after

receipt of such written notification to move this Board for a protective order that any such individual not be given access to Confidential Information. In the event such a motion is duly made, no disclosure shall be made to such individuals until the Board decides such motion, or the parties resolve the matter by agreement. In addition, each of the individuals identified in Paragraph 3, infra, shall execute an affidavit, a duplicate original of which affidavit shall be filed with the Board by the party seeking to make the disclosure, prior to any such individuals receiving any of the Confidential Information pursuant to Paragraph 3, supra. The producing party will be served with a copy of the affidavit at the time it is filed.

5. The identification of information as Confidential Information shall be made at the time when an answer to an interrogatory or an answer to a request for admission is served, when a copy of a document is provided to the other party or when an inspection of premises or tangible things is made or when the information is otherwise provided to counsel. With respect to the deposition of any person, a claim that an answer discloses Confidential Information may be entered into the transcript. No person may attend a deposition where such information is given unless he or she is entitled to receive such information under a provision of this Protective Order. Additionally, each party shall have fourteen days after receipt of the deposition tran-

script within which to notify the other party of the portions of the transcript disclosing Confidential Information. The right to make such designation shall be waived unless made before the end of the fourteen day period. No deposition may be read by anyone other than counsel and the deponent during the fourteen day period. Upon being informed that a certain portion of a deposition discloses Confidential Information, each party must cause each copy of their custody or control to be so marked immediately.

6. Any document, answer to interrogatory or request for admission, and deposition transcript filed with the Board for any purpose and identified as containing Confidential Information or any pleading, motion or brief filed with the Board containing or disclosing Confidential Information shall be filed in a sealed envelope, marked on the outside with the title of this action, and identification of each document within and a statement substantially in the following form:

"CONFIDENTIAL SUBJECT TO PROTECTIVE ORDER
This envelope (or container) containing the above identified papers filed by (name of party), is not to be opened nor the contents thereof displayed or revealed except by order of the Board or by agreement of the parties."

7. Should counsel for any party desiring to use Confidential Information, or any summary thereof or extract therefrom, in open court during a hearing or the trial of this

action, prior to such use, he or she shall bring the confidentiality thereof to the attention of the Board and/or the producing party that designated the information as confidential. Counsel for the producing party may request that any portion of the transcript or exhibit containing such information be filed under seal with the Board, and be accorded confidential treatment as provided by the terms of this Protective Order. All those present at the time of such use shall be directed to treat such information as confidential, and counsel for the parties shall exercise all reasonable care not to disclose such materials needlessly in the public record of this proceeding nor to persons not entitled under this Protective Order to receive such information.

8. Acceptance by a party of any information, document or tangible thing identified as Confidential Information hereunder shall not constitute a concession that the information, document or thing is confidential. If, subsequent to the acceptance of information, documents or things identified as Confidential Information, a party wishes the Board to rule upon the other party's claim or confidentiality, that party may move the Board for such determination. In the resolution of such motion, the burden of establishing the confidentiality of the information, document or thing shall be on the party that made the claim of confidentiality.

9. Nothing in this Protective Order will prevent the disclosure of information or documents known to the parties or which is not otherwise confidential or which is the type of information that is not maintained in confidence by the party designating it as confidential.

10. In the event anyone shall violate or threaten to violate any terms of this Protective Order, the parties agree that the aggrieved party may immediately apply to obtain injunctive relief against any such person violating or threatening to violate any of the terms of this Order and, in the event the aggrieved party shall do so, the respondent person subject to the provisions of this Protective Order shall not employ as a defense thereto the claim that the aggrieved party possesses an adequate remedy at law. The parties and any other persons subject to the terms of this Order agree that the Board shall retain jurisdiction over it and them for the purpose of enforcing this Protective Order. If either party is required to bring action to enforce the Stipulated Protective Order, the prevailing party shall be entitled to recover its costs of said action, including an amount equal to its reasonable attorneys' fees and the costs incurred.

11. Neither the taking of any action in accordance with the provisions of this Protective Order, nor the failure to object thereto, shall be construed as a waiver of any claim or

defense in this action. The entry of this Protective Order shall not be construed as a waiver of any right to make any other type of objection, claim or other response.

12. This Protective Order shall supersede all prior oral or letter agreements between the parties relating to confidential treatment of information produced in discovery, and shall remain in full force and effective until modified, superseded or terminated by consent of the parties or by order of the Board.

13. All documents designated as confidential and all confidential transcripts shall, unless otherwise ordered by the Board, be returned to the party that furnished said confidential matter at the conclusion of the proceedings. "Conclusion" indicates the point in time at which an order dismissing the proceedings or a judgment by which the proceedings are concluded is entered. The terms of this Stipulated Protective Order shall be deemed to be binding on the parties to this proceeding as of

the date the Stipulated Protective Order is excused by counsel
for the parties.

Respectfully submitted,

ISAACMAN, KAUFMAN & PAINTER

Dated: 8/13/04

By:

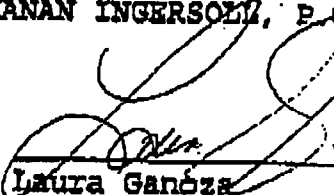


Michael A. Painter
Attorneys for Applicant

BUCHANAN INGERSOLL, P.C.

Dated: 8/12/04

By:



Laura Ganóza
Attorneys for Opposer